



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,319	12/30/1999	TAKAYUKI HASEBE	P21-9028	7660

32294 7590 04/14/2004

SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 04/14/2004

40

Please find below and/or attached an Office communication concerning this application or proceeding.

SK



**UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

40

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

In response to the Order Returning To Examiner of March 29, 2004, the attached letter indicates the corrective action taken by the examiner.

- Attachments:
1. Copy of Examiner's Answer with conferee initials.
 2. Copy of IDS (submitted 12/30/1999) fully considered.
 3. Copy of IDS (submitted 4/18/2000) fully considered.
 4. Copy of PTO-1449 (submitted 7/29/2002) fully considered.

Gilberto Barrón Jr.
Primary Examiner
Art Unit: 2132

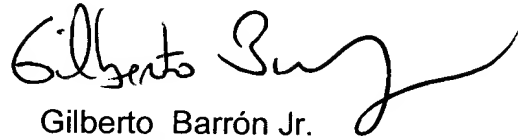
Response to Order

In response to the items for consideration and corrective action requested by Board of Patent Appeals and Interference in the Order Returning To Examiner, the following actions have been taken:

1. The IDS filed with the original Reissue on December 12, 1999 has been entered as a separate paper. A copy of the full paper, cover and PTO-1449 as initialed and dated on May 17, 2000 is attached. The actual references submitted were considered as indicated by the examiner's signature and date of May 17, 2000. However, a separate entry for this paper was not given at that time.
2. The IDS of July 29, 2000 has been considered and the initialed PTO-1449 is provided with the response.
3. A copy of the Examiner's Answer with appeal conferee initials is attached hereto. The copy mailed on 12/4/03 did not have conferees' initials. However, the second and third copies of the examiners answer (normal practice is to prepare three copies) were signed by the conferees and were present in the file at the time the examiners answer was mailed. A copy of the Examiner's Answer including with the original last sheet with original conferee signatures and a new sheet with conferee initialing is included for mailing to appellants. No changes were made to the original examiners answer.
4. No further corrective action is deemed necessary at this time. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Art Unit: 2132

5. Any inquiry concerning this communication should be directed to Gilberto Barrón Jr. at telephone number 703-305-1830.

A handwritten signature in black ink, appearing to read "Gilberto Barrón Jr.", with a stylized flourish extending from the end.

Gilberto Barrón Jr.
Primary Examiner
Art Unit 2132



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

DEC 04 2003

Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 36

Application Number: 09/476,319
Filing Date: December 30, 1999
Appellant(s): HASEBE ET AL.

Douglas H. Goldhush, Reg. No. 33,125
Squire, Sanders & Dempsey LLP
Tysons Corner, VA
For Appellant

MAILED

APR 14 2004

Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 30, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 6, 11, 17-19, 23-29, 33-39, 43-49, 53-56, 11-113, 19, 123, 124, and 125 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 2132

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

Claims 1-56 and 111-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are directed to non-functional descriptive matter. Non-functional descriptive matter is that which exhibits no functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. The instant claims recite a storage medium with two or three storage areas. However, none of the storage areas provide for descriptive matter that provides for a functionality either to the data as structured or a process to be implemented on a computer. The claims seek to patent a storage medium that is a repository for specific type data, but that data is not functional in nature. The data on the storage medium is solely to be acted on by another process when imparted to a computer.

The original patent application 08/603,760 amended the pending claims by adding to the preamble "accessed by a vendor computer and user computer, said

storage medium""information readable by said user computer, said storage medium" to overcome the 101 non-statutory rejection raised at that time. However, it is not clear that the claims of this reissue application provide for functional descriptive matter, either with claims that still retain the preamble that was originally amended or with the newly added claims that do not have the amendatory language.

(11) Response to Argument

The Final Rejection (paper no. 30) referenced the MPEP guidelines for computer related inventions. The section referred to is 2106, section II, (a). That section includes a reference to *Arrhythmia*. The purpose in referencing this section was to argue that claiming descriptive material on a computer readable medium does not make the invention eligible for patenting if the material is non-functional descriptive material. The argument was to indicate that the claimed invention as a whole must accomplish a practical application that can only result from descriptive material that in some manner is functional in nature. The claimed invention should then seek to impart, i.e. by being embodied on a computer readable medium, that functionality to produce a "useful, concrete and tangible" result to have a practical application.

In analyzing the claimed invention, none of the 40 independent claims (and their 31 dependent claims) recites a step, a series of steps, a process, method, program, instructions, or any other functional descriptive material that would cause or instruct a computer to perform step(s) that are part of a particular process or method to result in a practical application. The data structure of the instant claims is non-functional, in this sense, because it does not set forth any active step(s) of any process or any method.

Art Unit: 2132

None of the limitations in any one of the independent claims is a description of an active step or action to be taken by a computer as part of a process or method.

Nevertheless, even if the descriptive material does not set forth a process or method, or even a step, or steps as part of a process or method, the descriptive material may still be functional. As in *In re Lowry*, 32 USPQ 2d 1031, the functionality of a data structure may lie in its ability to organize stored data or in the management of data to be stored. The data structure of *Lowry* had a functionality that when imparted to a computer resulted in the practical application of organizing stored data in a computer memory in a way that also happened to more efficient and flexible.

However, in the instant case, none of the 40 independent claims recite an invention that, as a whole, is a description of material that is functional in the sense that it may impose a particular organization on a computer system or provide a framework under which the operation of a computer may be improved. The data structure described in the claims is a data structure without a functionality that could be imparted to a computer so as to affect a particular organizing structure, operation or a process of a computer, or in any way result in an improved computer.

The data structure that is recited in each of the independent claims is non-functional because it only describes types of non-functional data and the logical relationship between the various types of non-functional data. However, none of the different types of data that are described is a step, method, or process of encryption. The claimed invention is a storage medium that is readable by a device (read computer) that has two types of data, neither of which is functional. One type of data is an

encryption key and one other type of data is the encrypted data. None of the different data types described in the claims is an operation, transform, or function.

Applicant argues that the various data on the storage medium interrelate and affect each other, and interrelate with and operate in conjunction with elements of a computer. The relationship between the data types recited in the claims is abstract in nature as it conveys the general proposition that one type of data is an encryption key, while the second data is encrypted data. The only descriptive material that appears to recite functionality in the claimed invention is one describing how one type of data is to be used. Using claim 114 as exemplary (Claim 114 is the shortest and presumable the broadest claim under appeal.), the phrase "wherein the first data is used by the device to decrypt the encrypted data" is an example of such material. Here, neither the first data, nor the encrypted data is functional in nature. The storage medium does not include as one type of data, an encryption method or process which can be imparted to a device so as to instruct or program the device to use the first data to decrypt the other data on the storage medium, e.g. the encrypted data. The claim recognizes that the invention does not provide for such functionality, but rather it is left to the device to be already knowledgeable about how the decryption (or encryption) is to be performed.

The examiner agrees that the data on the storage medium will interrelate and operate with elements of a computer, but merely describing what a computer will do with the data should not warrant ascribing that functionality to the data structure that comprises the storage medium of the invention. The computer is already charged with that functionality. The claimed storage medium does not claim a data structure that

Art Unit: 2132

imparts the functionality for instructing a computer on how to use the first data to decrypt the encrypted data. The data structure on the storage medium only provides the data that a computer uses in a process that is already known to the computer and that process is not imparted to the computer from the descriptive material on the storage medium. To argue that a storage medium, that solely provides the raw data on which a computer will use in a process already known to the computer, imparts functionality to a computer is to argue that a CD with music recorded thereon imparts functionality to a computer because the computer will decode the data recorded thereon to result in a musical presentation.

The examiner also agrees with Applicant that an article of manufacture may be statutory. However, when the article of manufacture is merely the carrier for non-functional descriptive material, as in a CD with music recorded thereon, the invention would not pass muster under §101. All of the appealed claims are directed to a storage medium which is comprised of different types of data or has different areas for storing the different types of data. However, none of the data types and none of the data structures resulting therefrom, are functional in nature. Nor can they be shown to impart functionality to a computer when a computer accesses the claimed storage medium simply because that functionality is already charged to the computer.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 2132

Respectfully submitted,

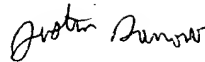


Gilberto Barrón Jr.
Primary Examiner
Art Unit 2132

gbj
November 26, 2003
Conferees:



Matthew Smithers
Primary Examiner AU 2134



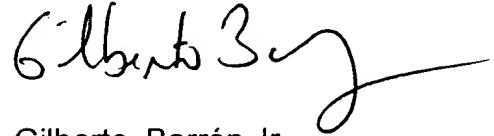
Justin Darrow
Primary Examiner AU 2132

NIKAIDO MARMELSTEIN MURRAY & ORAM LLP
655 FIFTEENTH STREET NW
SUITE 330
WASHINGTON, DC 20005-5701

Application/Control Number: 09/476,319
Art Unit: 2132

Page 8

Respectfully submitted,



Gilberto Barrón Jr.
Primary Examiner
Art Unit 2132

gbj
November 26, 2003
Conferees:

MSR 4/5/04

Matthew Smithers ²¹³⁷
Primary Examiner AU ~~2134~~

JD

04/08/2004

Justin Darrow
Primary Examiner AU 2132

NIKAIDO MARMELSTEIN MURRAY & ORAM LLP
655 FIFTEENTH STREET NW
SUITE 330
WASHINGTON, DC 20005-5701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue application of:

HASEBE et al.

Group Art Unit: 2202 (EXPECTED)

U.S. Patent Number: 5,796,824

Examiner: BARRON JR., G. (EXPECTED)

Issue Date: August 18, 1998

For: AN ELECTRONIC DATA PROTECTION SYSTEM

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

December 30, 1999

Dear Sir:

In consideration of applicants' duty of disclosure under 37 C.F.R. §1.56 and 37 C.F.R. §1.97, applicants wish to bring to the Examiner's attention the documents cited in the parent application, U.S. Patent No. 5,796,824, issued August 18, 1998, which are listed on the attached Form PTO-1449. Pursuant to 37 C.F.R. § 1.97(d), copies of these documents are not provided.

In particular, applicants would like to bring specific attention to three of the references cited in the parent application:

a) Santon et al. (5,058,162) cited against the related parent application now granted as U.S. Patent 5,392,351.

The feature of Santon et al. is that a media edition identifier information is stored in a storage media together with encrypted files.

The media edition identifier information is related to a password. The password is distributed, separately from the media edition identifier information, from a software distributor to a user.

Thus, a decryption of a storage media cannot be achieved if the storage media contains the media edition identifier information which does not agree with the password.

b) Brotby (4,785,361) cited against both the related divisional application now granted U.S. Patent 5,555,304 and the related application of U.S. Patent 5,796,824 to be reissued.

The feature of Brotby is that fingerprint information is written at a location of a storage media on which a user apparatus cannot write any information.

If a certain value is read out, when using a storage media, as the fingerprint information, it is determined that unauthorized storage media is used and the data cannot be read out therefrom.

c) Yamagishi (5,379,433) cited against the related application now granted as U.S. Patent 5,796,824 to be reissued.

The feature of Yamagishi is that a specific identification code is recorded on a storage media at a location where a user cannot rewrite data recorded thereat.


On the other hand, a predetermined ID code is recorded in a program stored in the storage media.

If it is determined that, when using the storage media, the read-out predetermined ID code does not match the read-out specific identification code, the computer stops execution of the above program.

In the event any fees are required with respect to this paper, please charge our Deposit Account No. 14-1060.

Respectfully submitted,

NIKAIDO, MARMELSTEIN, MURRAY & ORAM LLP



Ellen Marcia Emas
Attorney for Applicants
Registration No. 32,131

Attorney Docket No. P21-9028

Metropolitan Square
655 Fifteenth Street, N.W.
Suite 330 - G Street Lobby
Washington, D.C. 20005-5701
(202) 638-5000

EME:cf
Enclosure: PTO-1449

FORM PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. P21-9028	PATENT NO. 5,796,824
LIST OF REFERENCES CITED BY APPLICANT <i>(Use several sheets if necessary)</i>		APPLICANT HASEBE et al.	
		ISSUE DATE August 18, 1998	GROUP 2202 (EXPECTED)

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
GB ↑ ↓ ✓ GB	AA	5,058,162	Oct. 15, 1991	SANTON et al.	—	—	
	AB	4,757,534	July 12, 1988	MATYAS et al.	—	—	
	AC	5,065,429	Nov. 12, 1991	LANG	—	—	
	AD	4,683,553	July 28, 1987	MOLLIER	—	—	
	AE	5,010,571	Apr. 23, 1991	KATZNELSON	—	—	
	AF	4,850,017	July 18, 1989	MATYAS, JR. et al.	—	—	
	AG	4,577,289	Mar. 18, 1989	COMERFORD, et al.	—	—	

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION		
							YES	NO	PART.
GB ↑ ↓ ✓ GB	AH	3-83132	Apr. 9, 1991	JAPAN	—	—			✓
	AI	0 268 139	May 5, 1988	EUROPE	—	—	✓		
	AJ	0 144 522	Aug. 1, 1984	EUROPE	—	—	✓		
	AK	WO 88/02202	Mar. 24, 1988	PCT	—	—	✓		
	AL								
	AM								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

GB	AM	Albert et al., Computer, Vol. 17, No. 4, April, 1984, Long Beach, California, "Combating Software Piracy by Encryption and Key Management"
	AN	
	AO	

EXAMINER Gilberto Barran Ta	DATE CONSIDERED 5/17/00
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

FORM PTO-1449

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

P21-9028

SERIAL NO. 5,091,476, 31
NOT ASSIGNED

LIST OF REFERENCES CITED BY APPLICANT

(Use several sheets if necessary)

APPLICANT

HASEBE et al.

FILING DATE

December 29, 1999

GROUP

2767
2202
(EXPECTED)

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
5/18	AA	5,379,433	Jan. 3, 1995	YAMAGISHI			
	AB	5,276,735	Jan. 4, 1994	BOEBERT et al.			
	AC	4,866,769	Sept. 12, 1989	KARP			
	AD	5,287,408	Feb. 15, 1994	SAMSON			
	AE	5,199,066	Mar. 30, 1993	LOGAN			
6/17	AF	4,785,361	Nov. 15, 1988	BROTTY			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO PART.		
	AG								
	AH								
	AI								
	AJ								
	AK								
	AL								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

	AM	
	AN	
	AO	

EXAMINER

Gilberto Barrón Jr

DATE CONSIDERED

5/17/00

*EXAMINER:

Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

2767

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

APR 20 2000

Group 2700

In re application of:

HASEBE et al.

Serial Number: 09/476,319

Filed: December 30, 1999

For: AN ELECTRONIC DATA PROTECTION SYSTEM



#2

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97

Commissioner for Patents
Washington, D. C. 20231

April 18, 2000

Sir:

In compliance with applicants' duty of disclosure under 37 C.F.R. §1.56, the following is material information of which applicants are aware, and which is relevant to the above-identified application:

- (1) Japanese Patent Publication No. JP-A-3-30020
- (2) Japanese Patent Publication No. JP-A-62-108629
- (3) Japanese Patent Publication No. JP-A-1-194029
- (4) Japanese Patent Publication No. JP-A-62-226335
- (5) Japanese Patent Publication No. JP-A-61-204807

A copy of the above-cited references and the Office Action for the corresponding Japanese application are attached hereto.

RECEIVED

APR 20 2000

Group 2700

The undersigned hereby certifies that each item of information contained in the attached Information Disclosure Statement was cited in a communication from the Japanese Patent Office dated January 18, 2000, in a counterpart foreign application which is not more than three (3) months prior to the date of filing of this Information Disclosure Statement.

Should any fees be necessary in connection with the filing of this paper, please charge them to Counsel's Deposit Account No. 01-2300.

Respectfully submitted,

Arent Fox Kintner Plotkin & Kahn


George E. Gram, Jr.
Attorney for Applicants
Registration No. 27, 931

Atty. Docket No. P100021-09028

1050 Connecticut Ave., NW, Suite 600
Washington, D.C. 20036-5339
(202) 857-6000

GEO:cla

Enclosures: PTO-1449
Documents
European Search Report

FORM PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. P100021-09028	SERIAL NO. 09/476,319
LIST OF REFERENCES CITED BY APPLICANT (Use several sheets if necessary)		APPLICANT HASEBE et al.	
		FILING DATE December 30, 1999	GROUP RECEIVED APR 20 2000 276

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
F	AA						
	AB						
	AC						
	AD						
	AE						
	AF						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO PART.		
SB	AG	JP-A-3-30020	Feb. 8, 1991	Japan			✓		
	AH	JP-A-62-108629	May 19, 1987	Japan			✓		
	AI	JP-A-1-194029	Aug. 4, 1989	Japan			✓		
	AJ	JP-A-62-226335	Oct. 5, 1987	Japan			✓		
CB	AK	JP-A-61-204807	Sep. 10, 1986	Japan			✓		
	AL								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

	AM	
	AN	
	AO	

EXAMINER Gilberto Barron Jr	DATE CONSIDERED 5/17/00
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

FORM PTO-1449

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

58622-09028

SERIAL NO.

09/476,319

LIST OF REFERENCES CITED BY APPLICANT

(Use several sheets if necessary)

APPLICANT

HASEBE et al

FILING DATE

December 30, 1999

GROUP

2132

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
AA						
AB						
AC						
AD						
AE						
AF						

RECEIVED

AUG 01 2002

Technology Center 2100

FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO PART.
68	AG 63-20790	01/28/88	Japan			xx
68	AH 61-105986	07/05/86	Japan			xx
	AI					
	AJ					
	AK					
	AL					

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

AM	
AN	
AO	

EXAMINER

Gilberto B.

DATE CONSIDERED

4/5/04

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.